

REMARKS

This application has been reviewed in light of the Office Action dated December 2, 2004. Claims 1-13, 19-26, 28-31, 33, and 34 are presented for examination, of which Claims 1, 4, 19, 23, 25, 26, 28-31, 33, and 34 are in independent form, and have been amended to define still more clearly what Applicants regard as their invention. Claims 2, 3, 5-13, 20-22, and 24 have been amended as to matters of form only. No change in scope is either intended or believed effected by at least these latter changes. Favorable reconsideration is requested.

Claims 19-22, 28, and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,499,366 (*Rosenberg*); Claims 1-13, 25-26, 30, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rosenberg*, in view of U.S. Patent No. 6,324,545 (*Morag*); Claims 23, 29, and 34 were rejected under Section 103(a) as being unpatentable over *Rosenberg*, in view of U.S. Patent No. 5,787,254 (*Maddalozzo*); and Claim 24 was rejected under Section 103(a) as being unpatentable over *Rosenberg*, in view of *Maddalozzo* and further in view of *Morag*.

As shown above, Applicants have amended independent Claims 1, 4, 19, 23, 25, 26, 28-31, 33, and 34 in terms that more clearly define what they regard as their invention. Applicants submit that these amended independent claims, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

The rejection of independent Claims 19, 28, and 33 will be discussed first.

The aspect of the present invention set forth in Claim 19 is a method of automatically selecting a font from a collection of fonts for use in one or more texts. The method involves receiving the one or more texts and associated information. The method automatically selects one or more fonts from the collection of fonts, based on the associated information received with the one or more texts. The fonts of the one or more texts is set to one of the selected fonts.

Among other notable features of Claim 19 are receiving the one or more texts having associated information, and automatically selecting one or more fonts from the collection of fonts, based on the associated information received with the one or more texts.

Rosenberg relates to an expert system for suggesting and providing graphic design selections based on a user's desired result. The expert system provides a plurality of descriptors to define the characteristics of an output page or document. A user can weight the descriptors, as desired, and the expert system utilizes the weighted descriptors to select a number of solutions from a predefined database of possible solutions (see abstract).

In contrast to the method of Claim 19, the selection made by the expert system of *Rosenberg* depends on inputs provided by a user, and not on information associated with the text to which the selected font is applied. In Applicants' understanding, the decisions regarding the fonts and layouts in *Rosenberg* are made without reference to the texts to which the fonts are to be applied.

As described with reference to Figure 7 of *Rosenberg*, the user selects an advisor module (step 702) and inputs various criteria (step 704 and 705). The user then activates the advise button (step 706), and the advisor module displays sample objects or a list of object

names. This entire process is performed without reference to the texts to which the advised features are to be applied. Only later, in step 712, is the selected recommendation applied to the presentation or chart.

The advisor modules of *Rosenberg* are further described with reference to Figures 3-6. The advisor modules advise on presentation features of master pages, fonts, colors and numerical charts. In each case, the user supplies various criteria, and the expert system of *Rosenberg* makes recommendations based on the user's selected criteria.

Applicants have found nothing in *Rosenberg* that would teach or suggest receiving one or more texts having associated information, and automatically selecting one or more fonts from the collection of fonts, based on such associated information received with the text(s), as recited in Claim 19.

Accordingly, Applicants submit that Claim 19 is clearly patentable over *Rosenberg*.

Claims 28 and 33 are apparatus and computer program product claims, respectively, corresponding to method Claim 19, and are believed to be patentable over *Rosenberg* for at least the same reasons as discussed above in connection with Claim 19.

The rejection of independent Claims 1, 4, 25, 26, 30, and 31 will now be discussed.

The aspect of the present invention set forth in Claim 1 is a method of automatically selecting a font from a collection of fonts for use in one or more captions associated with one or more images. The method involves receiving the one or more images, which have associated information. The method automatically selects one or more fonts from the

collection of fonts, based on the associated information received with the one or more images, and sets the fonts of the one or more captions to one of the selected fonts.

Among other notable features of Claim 1 are receiving the one or more images having associated information, and automatically selecting one or more fonts from the collection of fonts, based on the associated information received with the one or more images.

As discussed above with respect to Claim 19, the expert system of *Rosenberg* makes recommendations based on criteria inputted by a user. In determining the recommendations, the expert system makes no reference to the text to which the recommendations are ultimately applied.

Accordingly, Applicants have found nothing in *Rosenberg* that would teach or suggest receiving one or more images having associated information, and automatically selecting one or more fonts from a collection of fonts, based on such associated information received with such image(s), as recited in Claim 1.

Further, the Office Action concedes that *Rosenberg* does not explicitly disclose that fonts are selected based on information provided with one or more images.

For at least the above reasons, Applicants submit that Claim 1 is clearly patentable over *Rosenberg*, taken alone.

The Office Action asserts that *Morag* describes the feature that fonts are selected based on information provided with one or more images. In particular, the Office Action asserts that *Morag* teaches automatically selecting themes (styles for documents) based on information associated with one or more images. Applicant respectfully disagrees, and submits that there is no teaching in *Morag* of an automatic selection of themes.

Morag describes a method of generating a personalized photo album. A customer acquires digital images and transmits the images to a service provider. The service provider arranges the images into an album format, prints out the images, assembles the album and mails the album to the customer. The user may provide instructions for the service provider to use in making the album arrangement. The instructions provided by the user may specify a font for use in labels. However, there is no teaching or suggestion in *Morag* of automatically selecting one or more fonts from a collection of fonts.

Column 2, lines 41-43, of *Morag* states that the customer defines and/or selects a, theme for a photographic album. The automatic arrangements of the album are preferably carried out in view of the theme selected by the user. In contrast, the method of Claim 1 receives one or more images, where the one or more images have associated information, and automatically selects one or more fonts from the collection of fonts, based on the associated information received with the one or more images.

Applicants have found nothing in *Morag* that would teach or suggest receiving the one or more images, where the one or more images have associated information, and automatically selecting one or more fonts from the collection of fonts, based on the associated information received with the one or more images, as recited in Claim 1.

Applicants therefore submit that a combination of *Rosenberg* and *Morag*, assuming such combination would even be permissible, also would fail to teach or suggest at least those features of Claim 1.

Accordingly, Applicants submit that Claim 1 is patentable over *Rosenberg* and *Morag*, whether considered separately or in combination.

Claims 25 and 30 are apparatus and computer program product claims, respectively, corresponding to method Claim 1, and are believed to be patentable over *Rosenberg* and *Morag* for at least the same reasons as discussed above in connection with Claim 1.

The aspect of the present invention set forth in Claim 4 is a method of automatically selecting a font from a collection of fonts for use in one or more captions associated with one or more images. The method involves receiving the one or more images, which have associated meta-data. The method analyses the meta-data received with the one or more images to determine a key feature amongst the meta-data. The method then searches a library of fonts, each font having a set of one or more associated key features, and automatically selects one or more fonts from the font library having an associated key feature best matching the determined key feature. A font of the one or more captions is set to one of the selected fonts.

Among other notable features of Claim 4 are receiving the one or more images, where the one or more images have associated meta-data, analyzing the meta-data received with the one or more images to determine a key feature amongst the meta-data, searching a library of fonts, each font having a set of one or more associated key features and automatically selecting one or more fonts from the font library having an associated key feature best matching the determined key feature.

As discussed above, Applicants submit that nothing has been found in *Rosenberg* that would teach or suggest receiving the one or more images, where the one or more images have associated meta-data, as recited in Claim 4.

Further, Applicants submit that nothing has been found in *Rosenberg* that would teach or suggest analyzing meta-data received with the one or more images to determine a

key feature among the meta-data, as further recited in Claim 4. Instead, the expert system advisor of *Rosenberg* acts according to criteria supplied by a user. For example, the Office Action cites a passage in *Rosenberg* from column 9, line 58, through column 10, line 35, as disclosing the analyzing feature of Claim 4. The cited passage merely relates to setting up a master page layout. However, setting up a master page layout may be done without any reference to text or images that will ultimately be displayed according to the chosen master page layout.

Furthermore, Applicants submit that nothing has been found in *Rosenberg* that would teach or suggest searching a library of fonts, each font having a set of one or more associated key features, and automatically selecting one or more fonts from the font library having an associated key feature best matching a determined key feature, as recited in Claim 4.

For at least the above reasons, Applicants submit that Claim 4 is clearly patentable over *Rosenberg*, taken alone.

Applicants also submit that *Morag* fails to remedy the deficiencies of *Rosenberg*, discussed above, and in particular, nothing has been found in *Morag* that would teach or suggest searching a library of fonts, each font having a set of one or more associated key features and automatically selecting one or more fonts from the font library having an associated key feature best matching the determined key feature, as recited in Claim 4.

Applicants therefore submit that a combination of *Rosenberg* and *Morag*, assuming such combination would even be permissible, also would fail to teach or suggest at least those features of Claim 4.

Accordingly, Applicants submit that Claim 4 is patentable over the *Rosenberg* and *Morag*, whether considered separately or in combination.

Claims 26 and 31 are apparatus and computer program product claims, respectively, corresponding to method Claim 4, and are believed to be patentable over *Rosenberg* and *Morag* for at least the same reasons as discussed above in connection with Claim 4.

The rejection of independent Claims 23, 29, and 34 will now be discussed.

The aspect of the present invention set forth in Claim 23 is a method of automatically selecting a font from a collection of fonts for use in one or more hyperlink texts, where the one or more texts are in an initial font. The method locates the one or more hyperlink texts, where the one or more hyperlink texts have associated information. One font is automatically selected from the collection of fonts, based on the associated information of the one or more hyperlink texts, and the initial font of the one or more hyperlink texts is replaced with the selected font.

Among other notable features of Claim 23 are locating the one or more hyperlink texts, where the one or more hyperlink texts have associated information, and automatically selecting one font from the collection of fonts, based on the associated information of the one or more hyperlink texts.

As discussed above, the expert system of *Rosenberg* depends solely on criteria selected by the user. Accordingly, Applicants submit that *Rosenberg* fails to teach or suggest locating the one or more hyperlink texts, where the one or more hyperlink texts have associated information, and automatically selecting one font from the collection of fonts, based on the associated information of the one or more hyperlink texts.

For at least this reason, Claim 23 is believed patentable over *Rosenberg*, taken alone.

Maddalozzo is not seen to overcome the deficiencies of *Rosenberg* as prior art against Claim 23. *Maddalozzo* describes a system for a Web browser having as an object the provision of improved information retrieval method. A client has an interface for displaying a first hypertext document with one or more hypertext links to a second hypertext document located at a server. The *Maddalozzo* method tags latency and time period metrics with a URL address link. The latency and time period metrics are provided to a user, providing the user with an estimation of the length of time to access a server. With such information available, the user can make a decision whether to continue invoking a particular link or to terminate the linking process. The latency time display can be implemented by highlighting, coloring or changing the font of the link text.

Applicants submit that nothing has been found in *Maddalozzo* that would teach or suggest locating one or more hyperlink texts having associated information, and automatically selecting one font from a collection of fonts, based on such associated information of one or more hyperlink texts, as recited in Claim 23.

Applicants therefore submit that a combination of *Rosenberg* and *Maddalozzo*, assuming such combination would even be permissible, also would fail to teach or suggest at least those features of Claim 23.

Accordingly, Applicants submit that Claim 23 is patentable over the *Rosenberg* and *Maddalozzo*, whether considered separately or in combination.

Claims 29 and 34 are apparatus and computer program product claims, respectively, corresponding to method Claim 23, and are believed to be patentable over

Rosenberg and Maddalozzo for at least the same reasons as discussed above in connection with Claim 23.


The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Leonard P. Diana", written over a horizontal line.

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